REMARKS

Status of the Claims

Claims 1-31 are pending.

Claims 1-31 stand rejected.

I. Amendments to the Claims

The claims have been amended to more particularly point out what the applicant considers to be his invention. The amendments are fully supported by the specification using the tables provided in the specification.

II. Claim Rejections under 35 U.S.C. 112

Claims 1-31 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make or use the invention.

The Applicant respectfully traverses the Examiner's rejection for failing to provide a prima facie case of nonenablement. An analysis of the case law provides a six-part test required by the USPTO to form a valid nonenablement rejection. The Examiner must provide evidence from the application supporting each of these

elements for a rejection under the first paragraph of Section 112 to be proper.

1. a rational basis as to
   a. why the disclosure does not teach or
   b. why to doubt the objective truth of the statements in the disclosure that purport to teach
2. the manner and process of making and using the invention
3. that corresponds in scope to the claimed invention
4. to one of ordinary skill in the pertinent technology,
5. without undue experimentation, and
6. dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

The first test of enablement that the Examiner must address is whether there is a rational basis as to why the disclosure does not teach the claimed invention. Claim 1 is limited to a heavy weight filler that is no more than 1.95% of the volume of the core. The Examiner provides a conclusory statement that the limitation is not enabling while citing to the table on page 7 that fully supports the volume limitation of the claim in question. The Examiner is correct that the 1.95% by volume is for the use of zirconium dioxide.

Specification teaches that the volume of the filler must be less than 1.95% of the core/center. The volume of conventional fillers is too great to meet this limitation.

On page 2, the specification teaches that "*[c]onventional fillers used include calcium carbonate (specific gravity of 2.73), barium sulfate (sp. Gr. Of 4.3) and zinc oxide (sp. Gr. 5.6). Although these materials can be effectively used to increase the weight of a golf ball,* ***the inevitable volume occupied by these materials when incorporated into a center or core results in a reduction in the polymer/rubber of the center or core.***" (emphasis added) This clearly teaches to one skilled in the art that the volume of the filler used with lower specific gravity fillers is a problem as it reduces the rubber content.

The Applicant provides further teaching to those skilled in the art on page 8 of the specification, which discuses the results of the chart on page 7, "*[a]s clearly demonstrated by the test results, the use of heavy weight fillers results in a desirable lower PGA compression and a higher coefficient of restitution* ***relative to a core made with a filler having a lower specific gravity***. (emphasis added) Thus the specification clearly teaches to one skilled in the art that the higher specific gravity fillers achieve their benefits through reduced volume of filler. The examiner is directed to review the law and the

specification that allows the introduction of a verbal range.

The court addressed this situation in *Staehelin v. Secher*, 24 USPQ 2d 1513, 1516 (B.P.A.I. 1992) requiring the burden of proving the prima facie case of nonenablement holding that:

> It has been consistently held that the first paragraph of 35 USC 112 required nothing more than objective enablement . . . How such a teaching is set forth, whether by the use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims must be taken as complying with the first paragraph of 35 USC 112 unless there is a reason to doubt the objective truth of the statements relied upon therein for enabling support.

The Board described the unreasonableness of Staehelin's assertion that Secher's application was nonenabling:

> The error we see in Staehelin's approach to the question before us is that Staehelin would require a patent specification to be a blueprint which, if followed, would unfailingly reproduce exactly an applicant's claimed invention. However, the law does not require a specification to be a blueprint in order to satisfy the requirement for enablement under 35 USC 112, first paragraph.

The court is clear that the Examiner's basis for a finding of nonenablement must be reasonable. Furthermore the courts have stated that an illustrative example would

satisfy the requirements of enablement. The Applicant provides teaching that the volume of the heavy filler must less than that of a conventional filler and provides an illustrative example on page 7. The Examiner has not met the burden to establish why the specification does not enable a volume of 1.95% other than requiring an unreasonably strict enablement standard contrary to the law.

The second part of a prima facie case of nonenablement is providing proof that the specification does not adequately describe the manner of making and using the invention. The Applicant's detailed description on page 4 teaches that *"[t]he key criteria is that the filler material must have a specific gravity of at least about 5.6."* The specification discusses the steps for producing a heavy filler core and refers to the table on page 7 for illustrative examples.

In re Hayes Microcomputer Prods. Inc. Patent Litig., 982 F.2d 1527, 25 USPQ 2d 1241 (Fed. Cir. 1992) the claims recited a software timer but the specification only described a known microprocessor that one skilled in the art knew could perform a timing function. The Federal

Circuit held that the specification sufficiently described how to make and use the invention in broad terms:

> One skilled in the art would know how to program a microprocessor to perform the necessary steps described in the specification. Thus, an inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains. Disclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of section 112, first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out.

Thus *Hayes Microprocessor* illustrates that the use of functional language is sufficient to enable a specification disclosing and claiming an invention. The examples from the Applicant's specification provides the functional language that would enable one skilled in the art to make or use the invention having a filler volume of 1.95%. Thus the Examiner fails to show that the specification fails to enable the making and using of the invention. The Examiner's statement that one skilled in the art of golf ball manufacture would not be able to measure a volume of less than 1.95% for the heavy filler is not reasonable.

The third element of forming a valid prima facie case of nonenablement is whether there is a correspondence in scope to the claimed invention. The Examiner states an

assertion contrary to the law regarding enablement requirements by stating that "*[t]he table discloses 1.95% by volume of zirconium dioxide present in the core and 0.48% by volume of tungsten; the remaining values between zero and 1.95% as claimed are not enabling. Furthermore, the values are only relevant to the zirconium dioxide and tungsten; quantities are not given for the remaining heavy fillers claimed by applicant.*" The Examiner correctly concedes that the claimed volumes of 1.95% and 0.48% are enabled and taught by the specification. The Examiner is incorrect that the specification is not enabled for values between zero and 1.95%.

The examiner continues to ignore the clearly pointed out section regarding the teaching of the table. There are no quantities required by law to support the quantities of bismuth, copper, bismuth oxide, nickel, cobalt, iron, steel, tin, chromium, bismuth subcarbonate, cupric oxide, barium tungstate and cuprous oxide that are all defined by their specific weight in table 1 and thus supported by the examples.

In *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 3 USPQ 2d 1737, 1743 (Fed. Cir.) *cert. denied*, 484 U.S. 954 (1987) the Federal circuit stated:

> If an invention pertains to an art where the results are predictable, e.g., mechanical as opposed to chemical arts, a broad claim can be enabled by disclosure of a single embodiment . . . and is not invalid for lack of enablement simply because it reads on another embodiment of the invention which is inadequately disclosed.

The Examiner improperly rejects the claim as being nonenabled by the specification for failing to provide multiple examples of the heavy filler. The Examiner rightly concedes that the specification is enabled for a volume of 1.95% and 0.48%. Volume is clearly part of the mechanical arts and volumes can be determined by one skilled in the art using Applicant's specification for guidance. The claimed range of a volume of less than 1.95% is clearly enabled. There is no requirement that enablement of the claims requires providing examples for the all the remaining heavy fillers claimed.

The fourth element that must be proven to establish a valid prima facie case of nonenablement is that the claim is not enabled to one skilled in the art. The Examiner has failed to show that one skilled in the golf ball arts would not be capable of determining the volume of less than 1.95% of a core or center. The limitation of volume in conjunction with the disclosed specific gravity range in

the specification is self explanatory on its face and requires such a low level of skill that one skilled in the art would need no further instruction on how to make or use the Applicant's invention given the disclosure of the specification.

In *In re Naquin*, 398 F.2d 863, 158 USPQ 317, 319 the court held that "[t]he specification need describe the invention only in such detail as to enable a person skilled in the relevant art to make and use it." When the holding of Naquin is applied to the present facts, the application is enabled to one skilled in the art regarding a volume range.

The fifth element of a prima facie case of nonenablement is that the lack of description in the specification causes a burden of undue experimentation to make or use the invention. In *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789 (C.C.P.A. 1974) the court held that *"[t]he Board expressed concern that 'experimentation' is involved in the selection of proportions and particle sizes, but this is not determinative of the question of scope of enablement. It is only undue experimentation which is fatal. . ."* There is no undue experimentation required to include a volume of heavy filler less than

1.95% given the information of the specific gravity of the heavy filler. Thus the Examiner has failed to address how the description in the specification would require undue experimentation to produce the claimed volume and therefore it is enabled.

The sixth and final requirement in producing a prima facie case of nonenablement is showing that the information lacked is not available to one skilled in the art. The Examiner has conceded that the specification discloses and enables the examples and volumes of tungsten and of zirconium dioxide. The Examiner states that the remaining values between zero and 1.95% are not enabling. Thus the Examiner is implying with the above statement that the calculation of volume for heavy fillers between zero and 1.95% requires information that is lacking in one skilled in the art. This is not a valid argument because even one having the lowest required skills in the art would be able to calculate a volume less than 1.95% when provided with the specific gravity. Furthermore the examiner fails to address the table with the specific gravity for each claimed heavy filler. The examiner must apply a standard of one skilled in the art and thus the calculation of the volume given the teaching of the specification would be in

the within the capacity of a high school graduate with basic math skills and thus enabled to one skilled in the golf ball core production arts.

The Applicants have shown with the above arguments and case law that the rejection under 35 USC 112, paragraph one is not proper. A valid prima facie case of nonenablement requires that the Examiner proves each of the six required elements. None of the elements have been shown to reasonably exist by the examiner. Applicant respectfully requests that the rejection be reconsidered and removed.

III. Claim rejections under 35 U.S.C. 103

Claims 1-31 stand rejected under 35 U.S.C. 102(e) as being obvious under 103(a) as being unpatentable over Sullivan (USPN 5,833,553) in view of Tanaka et al (5,730,663) and Yabuki et al (5,482,285). Applicant responds to the rejection of claims 1-31 with an enclosed Rule 131 declaration by the sole inventor Sanjay Kuttappa that should effectively remove the Sullivan `553 patent reference from consideration.

The combination of remaining references of Tanaka and Yabuki fails to teach the claimed invention, either singly, or in combination. The Applicant respectfully requests reconsideration and allowance of claims 1-31.

IV. Conclusion

The applicant respectfully requests reconsideration and removal of all rejections of claims 1-31 in light of the enclosed Kuttappa 131 declaration. The applicant courteously solicits a notice of allowance.

Respectfully submitted,

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Enclosure: Kuttappa Rule 131 Declaration

Certificate of Mailing under 1.8

The undersigned hereby certifies that this paper along with any paper or document referred to therein as being attached or enclosed, is being deposited with the United States Postal Service to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450- This 8th day of March, 2004.

Jeffrey D. Washville